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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Carl J. EVANS et al.

Application No.: 09/304,787

Group Art Unit: 2684

Filed: May 4, 1999

Examiner: Sobutka, P.

Attorney Docket: 09710-1113

Client Docket: COS-98-009

For: ADVERTISEMENT BROADCASTING FOR PAGING

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REPLY BRIEF

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted, in triplicate, in response to the Examiner's Answer mailed January 29, 2004.

I. EXECUTIVE SUMMARY

Applicants are associating a capcode with a subscriber **service in addition** to associating the capcode to a unique physical pager **hardware**; the service association being new and the hardware association being conventional.

II. CLAIMS 1-7, 13 -28 ARE NOT OBVIOUS OVER TAUBENHEIM ET AL. IN VIEW OF FASCENDA ET AL., LEWIS ET AL., DELUCA ET AL., YEH ET AL. AND DIMITRIADES ET AL.

Appellants are directing this appeal only to claim 1 (the other claims may be important with respect to other issues, e.g., other references and other combinations). Therefore, only the paragraph spanning pages 3, 4 and the last paragraph on page 6, of the EXAMINER'S ANSWER, are relevant to this appeal. Appellants agree with the Examiner's statements in these two paragraphs (this agreement is set forth in more detail in the APPEAL BRIEF, VIII. B. first 21 lines).

In the Examiner's combination, the capcode is generated in association with a single physical pager, as an ID. By contrast, Appellants' claimed invention generates the capcode to add information to a prior art pager ID; the added information being an association with an advertisement script. The added association is not a part of the pager ID, but IDs the type of advertising service provided to that pager; claim 1 states:

“generating a capcode associated with an advertisement script;
and”

Appellants' embodiment exemplifies this:

“different capcodes could be generated so that residential customers could be separated from business customers and large business customers could be separated from small business customers. . . . customers may have their advertisement broadcast capcode added or removed ... any time via over the air programming” (specification page 8, lines 13-28)

Claim 1 **follows** the above-quoted “generating” step with the following step where “the” has been emphasized for antecedent purposes to refer to the previously generated capcode and show that the attaching step follows the generating step:

“attaching **the** advertisement script to a message for a paging service subscriber associated with **the** capcode.”

In essence, the EXAMINER'S ANSWER associates the capcode (that identifies only the unique physical pager) with the message and advertisement script by combining these three

elements into one concatenated entity. In contrast, Appellants' claimed invention first generates the capcode to not only identify the unique physical pager, but also to identify an association with an advertisement script, such as the embodiment residential or business association. Thereafter, in a separate step, the claimed invention attaches the advertising script to a message for a paging service subscriber associated with **the** capcode. In Appellants' claimed invention, the associating is not the attaching *per se* as in the prior art.

Below is a comparison of the invention of *AT&T Corp. v. Excel Communications, Inc.*, (cited in the APPEAL BRIEF) in the first line, with Appellant's claim 1 in the second line:

- (1) information is added to a standard ID code to provide a new capacity, differential billing services;
- (2) information is added to a standard ID capcode to provide a new capacity, differential ad services.

Appellants' embodiment uses some of the digits of the capcode, not for association with a specific pager (this is done with other digits of the capcode), but for unique association with different advertisement scripts.

The Examiner has failed to show anything more with respect to the features claim 1 than what is admitted to be conventional.

III. CONCLUSION AND PRAYER FOR RELIEF

The claims require generating a capcode associated with an advertising script, and another step of attaching the advertisement script to a message for a paging service subscriber associated with the capcode. No combination of the references provides or suggests this. Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

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3/29/04
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